

REMARKS

Status of the Claims

Claims 1, 3-4, and 6-18 will be pending in the above-identified application upon entry of the present amendment. Claims 6-18 are currently withdrawn from consideration. Claims 1 and 3-4 stand ready for further action on the merits. Claims 1 and 4 have been amended. Claims 20-22 have been cancelled herein. Support for the recitations in claims 1 and 4 can be found in the specification, *inter alia*, at page 23. Thus, no new matter has been added. Based upon the above considerations, entry of the present amendment is respectfully requested.

Applicants submit that the present Amendment is merely formal in nature, reduces the number of issues under consideration, and places the case in condition for allowance. Alternatively, entry of the present amendment is proper to place the claims in better form for appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 112

The Examiner has rejected claims 1 and 4 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Specifically, the Examiner asserts that there is no disclosure in the present specification that both the hydrophobic organic compound (A) and the emulsifying and dispersing agent (B) are enclosed within the water-soluble saccharide. Applicants respectfully traverse.

The Examiner notes that page 39, second paragraph, of the present specification recites that “the (A) component evenly dispersed by the function of the (B) component is enclosed with the (C) component.” The Examiner interprets this statement as only the (A) component is enclosed. However, one of ordinary skill in the art would understand that this statement recites that the (A) component is uniformly dispersed by the function of the (B) component and that a dispersion of the (A) component and the (B) component is enclosed by the (C) component.

Furthermore, the Examiner asserts that there are no examples or analyses demonstrating such an enclosing. Applicants also respectfully traverse this assertion. Such a combination of the (A) component, the (B) component, and the (C) component is supported by test data as shown in Tables 1 and 2 of the present specification.

For the reasons given above, Applicants respectfully submit that claims 1 and 4 comply with the written description requirement. Accordingly, Applicants respectfully request that the rejection be removed.

Issues under 35 U.S.C. § 103(a)

1) The Examiner has rejected claims 1, 3-4, and 20-21 under 35 U.S.C. § 103(a) as being unpatentable over Ikeda et al. '278 (US 2002/0117278) in view of Xu et al. '024 (WO 01/48024) and further in view of Shibantai '132 (EP 251132).

2) The Examiner has rejected claims 20-22 under 35 U.S.C. § 103(a) as being unpatentable over Hallstrom et al. '259 (US 6,165,259).

Claims 20-22 have been cancelled herein, which renders the rejections moot as to these claims. With respect to the remaining claims, Applicants respectfully traverse, and reconsideration and withdrawal of the remaining rejection are respectfully requested.

Legal Standard for Determining Prima Facie Obviousness

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Exemplary rationales that may support a conclusion of obviousness include:

- (a) combining prior art elements according to known methods to yield predictable results;
- (b) simple substitution of one known element for another to obtain predictable results;
- (c) use of known technique to improve similar devices (methods, or products) in the same way;
- (d) applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (e) “obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success
- (f) known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- (g) some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. *See* MPEP 2143.03.

The Present Invention and its Advantages

As amended, independent claims 1 and 4 recite, *inter alia*, that “the emulsifying and dispersing agent (B) is a copolymer comprising composing units derived from at least one kind of non-ionic monomer having a dissolution parameter of 20.5 (MPa)^{1/2} or lower and at least one kind of cationic monomer.” The copolymer (B) of a non-ionic monomer and a cationic monomer provides the claimed composition with unexpected results in view of an improved

yield. These advantages are supported by Examples 3-5, 8, 10, and 12-17 of Table 1 in comparison with Comparative Examples 3, 9, and 11.

Distinctions over the Cited Art

As discussed above, independent claims 1 and 4 recite that the emulsifying and dispersing agent (B) is a copolymer of a non-ionic monomer and a cationic monomer wherein the non-ionic monomer has a specific dissolution parameter range.

Ikeda et al. '278 fail to disclose an emulsifying and dispersing agent (B) as defined by independent claims 1 and 4. Applicants respectfully submit that Xu et al. '024 and Shibantai '132 do not overcome the deficiencies of this reference.

As stated in *KSR International Co. v Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007), "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Furthermore, the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *Id.* As described above, Applicants have shown that the present invention achieves unexpected and unpredictable results.

To establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be disclosed by the cited references. As discussed above, Ikeda et al. '278 in view of Xu et al. '024 and Shibantai '132 fail to disclose all of the claim limitations of independent claims 1 and 4, and claim 3 dependent thereon. Accordingly, the combination of references does not render the present invention obvious. Furthermore, the cited references or the knowledge in the art provide no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the outstanding rejection is respectfully requested. Any contentions of the USPTO to the contrary must be reconsidered at present.

CONCLUSION

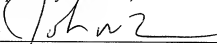
A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case clearly indicating that each of claims 1 and 3-4 are allowed and patentable under the provisions of title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Reg. No. 58,258 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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